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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	79141996
Applicant	GIORGIO S.R.L.
Applied for Mark	F**K PROJECT
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APPLICANTS: GIORGIO S.R.L., MAURO RUSSO, PAOLO GUIDI, ALESSANDRO ANTONIO AMBROGIO FALCONIERI, and M&M CONSULTING LICENSING S.R.L.

SERIAL NO.: 79/141,996 CLASSES: 18 and 25

FILED: October 18, 2013 EXAMINER: Christine Martin

MARK: F**K PROJECT (Stylized) LAW OFFICE: 104

APPEAL BRIEF OF APPLICANT

Applicant has appealed the Trademark Examining Attorney's refusal to register the mark "F**K PROJECT (Stylized)" on the Principal Register under Trademark Act § 2(a) claiming that Applicant's mark consists of or includes immoral or scandalous matter.

FACTS

On October 18, 2013, Applicant filed the present application to register the mark "F**K PROJECT (Stylized)" under the provisions of Section 66(a) of the Trademark Act as a Request for Extension of Protection to the United States and received U.S. Serial No. 79/141,996. The mark was filed for "Leather and imitations of leather; leather and imitation leather goods, namely bags, suitcases, backpacks, traveling bags, purses, key-cases of leather and skins, wallets, briefcases for documents; umbrellas" in International Class 018 and "Clothing, namely, T-shirts, shirts, jumpers, trousers, skirts, jeans, jackets, underclothes, bathing suits, hats and caps, footwear" in International Class 025.

In the initial Office Action dated February 5, 2014, the Examiner refused registration under Section 2(a) of the Trademark Act because of the allegedly immoral or scandalous nature of Applicant's "F**K PROJECT (Stylized)" mark.

Another Office Action was issued dated March 20, 2014, which superceded the February 5, 2014 Office Action. In the March 20, 2014 Office Action, the Examiner again refused registration under Section 2(a) of the Trademark Act because of the allegedly immoral or scandalous nature of Applicant's "F**K PROJECT (Stylized)" mark as well as requiring the Applicant to specify its entity type and citizenship.

On August 18, 2014, Applicant submitted a response to the Examiner addressing the Examiner's concerns in the first Office Action. In the response, Applicant clarified its entity type and citizenship. Applicant also argued that the proposed mark is not immoral or scandalous, that the Examiner did not meets its burden of proof in establishing that Applicant's mark is immoral or scandalous, and that even if Applicant's mark contained a substitute for an immoral or scandalous term, substitutes for such terms are not themselves immoral or scandalous.

On October 4, 2014, the Examiner issued a second, final Office Action that once again refused registration on the Principal Register under Section 2(a) of the Trademark Act because of the allegedly immoral or scandalous nature of Applicant's "F**K PROJECT (Stylized)" mark.

Applicant timely filed a Request for Reconsideration and Notice of Appeal on January 22, 2015. This *ex parte* appeal was acknowledged and instituted by the Board on January 22, 2015. On February 5, 2015, the Request for Reconsideration was denied. On February 6, 2015, the current *ex parte* appeal proceedings resumed.

ARGUMENT

I. THE MARK IS NOT IMMORAL OR SCANDALOUS.

The Applicant notes for the record that it is impossible for the fanciful term "f**k" to be considered immoral and scandalous, because there is no such word. The term "f**k" is not present

in the dictionary, and there is no commonly accepted definition of the term "f**k". Instead, the term "f**k" is a made up word that is incapable of offending or shocking the public decency, because each consumer who encounters the term will likely interpret the coined word differently. Thus, Applicant respectfully disagrees and believes that the Examiner has failed to make a *prima facie* showing of the immoral and scandalous nature of Applicant's mark.

A. The Examining Attorney has Failed to Present Sufficient Evidence that Applicant's Mark is Immoral or Scandalous

The U.S. Patent and Trademark Office has the burden of proving that a trademark falls within the prohibition of Section 2(a) for being immoral or scandalous. *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 31 UPSQ2d 1923, 1925 (Fed. Cir. 1994). *See also In re Standard Electrik Lorenz A.G.*, 371 F.2d 870, 152 UPSQ 563, 566 (CCPA 1967). The determination that a mark comprises scandalous matter is a conclusion of law based upon underlying factual inquiries. *Cf. Frederick Gash, Inc. v. Mayo Clinic*, 461 F.2d 1395, 1397, 174 USPQ 151, 152 (CCPA 1972) ("The inquiry under [15 U.S.C. § 1052(a)] is similar to that under...15 U.S.C. § 1052(d), which is likelihood of confusion of the marks as applied to the respective goods and/or services."); *Weiss Assocs., Inc. v. HRL Assocs. Inc.*, 902 F.2d 1546, 1547-48, 14 USPQ.2d 1840, 1841 (Fed. Cir. 1990). To support a Section 2(a) refusal, there must be evidence that a substantial portion of the general public would consider the mark to be scandalous in the context of contemporary attitudes and the relevant marketplace. *Mavety Media*, 33 F.3d at 1371-72, 31 USPQ2d at 1925-26; TMEP § 1203.01. To warrant refusal, the PTO must demonstrate that the mark is "shocking to the sense of truth, decency or propriety; disgraceful; offensive; disreputable; ... giving offense to the conscience or moral

feelings; ... [or] calling out [for] condemnation." *Mavety Media*, 33 F.3d at 1371, quoting *In re Riverbank Canning Co.*, 95 F.2d 327 (CCPA 1938).

The Examining Attorney has failed to meet this burden. In the Examiner's first Office Action, the Examiner first submitted dictionary.com references explaining that the term "fuck" is vulgar. However, vulgar is not the legal standard. Instead, the standard is much higher. As elucidated by *Riverbank*, which is the leading pre-Lanham Act case on the subject, the legal standard is scandalous, which means "calling out for condemnation." *See In re Riverbank Canning*, 95 F.2d at 327 (CCPA 1938) (demonstrating that the standard require more than simply referring to something in bad taste, i.e., 'vulgar'). Moreover, the courts recognize "the inherent fallibility in defining the substantial composite of the general public based solely on dictionary references." *In re Runsdorf*, 171 USPQ 443 (1971); *In re Maverty*, 33 F.3d at 1373. Applicant further notes that Applicant's mark does not contain the word "fuck" in the mark. Simply put the term "f**k" is not shocking and does not call out for condemnation.

In the initial Office Action, the Examiner then submitted a wikiepdia article explaining that word filters may substitute various symbols in place of letters to avoid producing scandalous terms. Applicant notes that the same wikipeida article also explains the possibility of "false positives" in which words can be incorrectly censored and perfectly acceptable word usages may result in letters being replaced by asterisks. Applicant's mark is a humorous attempt to suggest such a "false positive" result.

The last pieces of evidence the Examiner included in the initial Office Action consisted of a few instances in which the word "fuck" may be censored as "f**k". Applicant notes, however, that the term "f**k" could refer to an infinite number of socially acceptable words such as "fork" or

"flack". It is also possible that the letters "f" and "k" are initials of different words and the asterisk symbols serve a merely decorative use, rather than serving as placeholders for letters that would result in a scandalous term. In sum, the term "f**k" is not present in the dictionary, and there is no commonly accepted definition of the term "f**k". Instead, the term "f**k" is a made up word that is incapable of offending or shocking the public decency, because each consumer who encounters the term will likely interpret the coined word differently. Even if a consumer interpreted the term "f**k" to be a substitute for the term "fuck," that does not mean that the fanciful term "f**k" itself is immoral or scandalous.

In the Examiner's second Office Action, the Examiner again submitted dictionary.com references explaining that the term "fuck" is vulgar. However, Applicant reiterates that vulgarity is not the legal standard. The primary definition of the term "vulgar" is defined as "not having good manners, good taste, or politeness." *See* [Exhibit C to Applicant's Response to the Second Office Action, Merriam-Webster dictionary definition of the term "vulgar"]. Therefore, it would appear that the term "fuck" may be considered an impolite word. The Examiner contends that "evidence that a mark is vulgar is sufficient to establish that the mark is scandalous within the meaning of Trademark Act Section 2(a)." However, it is difficult to reconcile such a statement with the fact that the term "vulgar" may also mean "relating to the common people or the speech of common people." *See id*. The speech of common people should not be considered shocking to the general public. Therefore, it may be that the term "fuck" is actually the speech of common people, which is explicitly permissible within the framework of the law. The legal standard for a scandalous mark requires much more than mere impoliteness and would certainly not encompass the speech of common people. The legal standard is scandalous, which means "calling out for condemnation."

See In re Riverbank Canning, 95 F.2d at 327 (CCPA 1938) (demonstrating that the standard require more than simply referring to something in bad taste, i.e., 'vulgar').

In the second Office Action, the Examiner then submitted several other pieces of evidence appearing to show the term "f**k" used in a trademark sense. For example, a book titled "F**K IT", followed by a clothing line titled "F**K IT", followed by a book series titled "F**K IT", as well as a documentary film titled "F**K". These uses of the term "f**k" are not evidence that the term "f**k" is shocking and calls out for condemnation. None of these pieces of evidence give any indication as to the potential meaning of the term "f**k", if that term has any concrete meaning at all. As a result, the Examiner merely entered into evidence potentially infringing trademarks rather than evidence as to the allegedly scandalous meaning of the term "f**k".

In the Second Office Action, the Examiner did include a single instance in which the word "fuck" might be censored as "f**k" in order to potentially form a comprehensible phrase. It is not clear from the evidence what the term "f**k" would mean within the news article titled "F**K Earth! Elon Musk wants to send million people to Mars to ensure humanity's survival," and it appears the Examiner has presupposed that the term "f**k" is being used as a substitute for "fuck," even though the evidence does not directly indicate that the word "f**k" is intended to be a censored version of the term "fuck."

The Examiner then submitted a piece of evidence titled "Whence the !@#$? How a dirty word gets that way." This piece of evidence actually undermines the Examiner's position that Applicant's "F**K PROJECT" mark, which does not even contain the allegedly scandalous term "fuck", would be perceived by the public as scandalous. The article submitted by the Examiner explains that as of 2007, the FCC would no longer levy indecency fines on broadcasters who

accidentally allowed the term "fuck" on the airwaves. The FCC reasoned that the word "fuck" is commonly used to express frustration rather than sexual obscenity. A term commonly used to express frustration would certainly not rise to the level of scandalous. The law requires that a scandalous mark be shocking and offensive to the public. As the evidence explains, the FCC would no longer fine accidental uses of the term "fuck," precisely because the term was no longer shocking and offensive to the public.

In the Examiner's denial of Applicant's Request for Reconsideration, the Examiner submitted a duplicative piece of evidence in the form of a documentary film titled "F**K", which uses the term "F**K" as a trademark. The Examiner also included a number of internet articles in which the word "fuck" might be censored as "f**k" in order to potentially form a comprehensible phrase. It is not clear from the evidence what the term "f**k" would mean within the internet articles titled "'Jesus Christ holy f**k' News 24 responds to Taiwan plane crash," the TMZ article "Justin Bieber Flips Out at Photog 'I'LL BEAT THE F**K OUT OF YOU'," and the Huffington Post article "Jon Stewart Has A Question For Rand Paul: 'What The F**k Are You Talking About?'." It appears that in each of these instances, the Examiner has merely presupposed that the term "f**k" is being used as a substitute for "fuck," even though nothing within those pieces of evidence directly indicates that the word "f**k" is intended to be a censored version of the term "fuck."

In summary, the record is wholly devoid of the requisite amount of evidence that the term "F**K" is a substitute for the word "fuck" and that the term "fuck" is scandalous. The reality is that the term "f**k" could refer to an infinite number of socially acceptable words such as "fork" or "flack". It is also possible that the letters "f" and "k" are initials of different words and the asterisk symbols serve a merely decorative use, rather than serving as placeholders for letters that would

result in a scandalous term. The reality is that the term "f**k" is not present in the dictionary, and there is no commonly accepted definition of the term "f**k". Instead, the term "f**k" is a made up word that is incapable of offending or shocking the public decency, because each consumer who encounters the term will likely interpret the coined word differently. Even if a consumer interpreted the term "f**k" to be a substitute for the term "fuck," that does not mean that the fanciful term "f**k" itself is immoral or scandalous.

Consumers will not interpret the mark "F**K PROJECT" as offending or shocking the public decency, as elucidated by the fact that the same mark has been registered in numerous other countries where English is the official language or widely spoken, such as the European Community, without any refusal. Similarly International Registration No. 1190861 for the mark "F**K PROJECT" was approved in Japan, Monaco, and Ukraine. Moreover, as espoused by the Examiner's evidence in the second Office Action, which consisted of an article titled "Whence the !@#$? How a dirty word gets that way" it has been established that the FCC would no longer fine broadcasters accidentally using the term "fuck," because the term is commonly used to express frustration rather than sexual obscenity. The fact that the term "fuck" has become an integral part of common parlance, and the term is often used in a manner to express frustration, clearly demonstrates that the term is not "scandalous" or "shocking to the public decency."

B. Substitutes for Vulgar Terms are not themselves Vulgar

Even if the Examining Attorney found additional evidence that the fanciful term "f**k" is a commonly understood substitute for the word "fuck," such evidence would be insufficient to find that the term "f**k" itself is immoral or scandalous. Conversely, such evidence would only serve

to strengthen the position that society had then adopted the fanciful term "f**k" as a non-offensive and socially acceptable alternative to the otherwise offensive term "fuck."

The present case is factually similar to the analogous case, *In re Big Effin Garage, LLC*, Serial Nos. 77595225 and 77595240 (November 23, 2010) [not precedential]. *See* [Exhibit A to Applicant's Response to the First Office Action, TTAB decision *In re Big Effin Garage, LLC*]. In that case, the examining attorney rejected marks containing "effin" and "f/n" as being immoral or scandalous as they are a common substitute for the word "fucking." The TTAB reversed the refusal, holding that the words "effin" and "f/n" are not scandalous precisely because the word is a substitute for a scandalous term. In that case, the Board reasoned that:

> while the evidence of record supports a finding that "effin" and "f'n" are used as substitutes for the offensive term "fucking," such evidence also indicates that these derivative terms are utilized as a substitute therefor precisely because they are less offensive, and may be used in conversation, on television, and on Internet message boards. Accordingly, the examining attorney's arguments regarding the scandalousness of the substituted "effin" or "f'n" ring hollow.

Id. at 7. The Examining Attorney contends that the cited case is distinguishable, because those terms at issue were nonliteral, slang forms of the word. However, the present case features circumstances even more favorable to Applicant, precisely because Applicant's mark is not a slang form of a supposedly vulgar word. Applicant's mark contains the fanciful term "f**k," which is not in and of itself scandalous or immoral.

Applicant's mark is actually a fanciful term that stands on its own without any reference at all to a potentially vulgar word. Applicant's mark contains the fanciful term "f**k," which is not in and of itself scandalous or immoral. Although the Examining Attorney has found a few instances where asterisks were used in a fashion similar to Applicant's mark as a potential substitute for a

scandalous or immoral word, the symbols themselves are not scandalous or immoral. Furthermore, the presence of asterisks next to letters does not necessitate that the resulting term would be scandalous or immoral. Finally, the article submitted by the Examiner in the Second Office Action titled "Whence the !@#$? How a dirty word gets that way" establishes that the FCC views the term "fuck" as a commonly used term to express frustration, as opposed to a sexual obscenity. The fact that the term "fuck" has become an integral part of common parlance, and the term is often used in a manner to express frustration, clearly demonstrates that the term is not "scandalous" or "shocking to the public decency."

The Federal Circuit has held that, to the extent there is doubt as to the immoral or scandalous nature of an applicant's mark, that doubt must be resolved in favor of publication of the mark for opposition. *In re Mavety Media Group Ltd.*, 31 UPSQ2d at 1928; and *In re Hines*, 32 USPQ2d 1376 (TTAB 1994). Here there is clearly doubt as to whether the term "f**k" would be considered scandalous or immoral, and such doubt should therefore be resolved in favor of Applicant.

The Applicant recognizes that prior determinations in other applications are not binding on the PTO. Nonetheless, given the strong public policy in favor of consistency of decisions, Applicant respectfully notes that a similar mark, U.S. Trademark Registration No. 4,142,745 for the mark "$#*! MY DAD SAYS" has been allowed by the USPTO. *See* [Exhibit B to Applicant's Response to the First Office Action, Trademark Registration No. 4,142,745 for the mark "$#*! MY DAD SAYS"]. Similar to the current case, the presence of symbols creates a term that could be interpreted as immoral or scandalous, or could be interpreted as standing for an infinite number of other commonly accepted words.

Assuming *arguendo* that the term "f**k" was a reference to the term "fuck," the mark "F**K PROJECT" would still not be offending or shocking the public decency, because the trademark would not make sense. Applicant is unsure what the perceived meaning of "fuck project" might be, because the phrase does not make sense. Expressions such as "fuck it" or "fuck you" that are directed as an offense toward someone or something would likely be considered offending or shocking the public decency. Even the phrase "fuck project," which is not Applicant's mark, sounds mildly pejorative as opposed to offensive or shocking to the public decency. It seems most likely that the phrase "fuck project," which is not Applicant's mark, would express some sense of frustration. As illuminated by the article titled "Whence the !@#$? How a dirty word gets that way" that the Examiner submitted, the FCC views the term "fuck" as a commonly used term to express frustration, which clearly demonstrates that the term is not "scandalous" or "shocking to the public decency." It is unlikely that the mark "F**K PROJECT" would cause outrage, because outrage is a strong feeling that motivates the sufferer to take strong and swift action. As explained above, the mark "F**K PROJECT" has been approved in other countries and there is no evidence that anyone has expressed any strong feelings that would motivate the sufferer to take strong and swift action in those locations. Applicant's mark is not illegal, blasphemous, racist, or discriminatory. The right to freedom of speech and freedom of expression should allow for expressions such as "F**K PROJECT", even if it possible that a small subset of society could interpret the mark as being slightly rude.

II. CONCLUSION

Based on the foregoing analysis, Applicant requests that the Trademark Trial and Appeal Board reconsider the original rejection of this application. As such, Applicant believes the mark

"f**k" is fanciful and should not be considered immoral and scandalous and respectfully requests that the present mark be passed to publication at an early date.

Respectfully submitted,

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Date

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